No. 89-1061

IN THE SUPREME COURT OF THE UNITED STATES
OCTOBER TERM, 1989

SEVENTH-DAY ADVENTIST CONGREGATIONAL CHURCH
AND JOHN R. MARIK,
Petitioners,
vs.
GENERAL CONFERENCE CORPORATION
OF SEVENTH-DAY ADVENTISTS,
Respondent.

ON PETITION FOR A WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

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QUESTIONS PRESENTED

1. Whether the decision of the Court of Appeals is in conflict with the decision of another federal court of appeals on the same matter?

2. Whether the decision of the Court of Appeals has so far departed from the accepted and usual course of judicial proceedings?

3. Whether this case is ripe for certiorari where the Court of Appeals has reversed the district court's judgment against the Petitioner, has remanded the entire case to the District Court, and has not made any determination adverse to Petitioner?

4. Whether certiorari review of a contempt order is proper where the order was not appealed from and was not ruled upon by the Court of Appeals?

5. Whether certiorari review of the Court of Appeal's refusal to take judicial notice of certain facts is proper and necessary where the Court of Appeals remanded the entire case to the District Court and the Petitioner may attempt to introduce the evidence at trial or move for the District Court to take judicial notice?

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BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

Respondent General Conference Corporation of Seventh-day Adventists respectfully requests that this Court deny the Petition for Writ of Certiorari seeking review of the Ninth Circuit Court of Appeals' decision in this case.

1. CITATIONS TO OPINIONS BELOW

A Judgment and Permanent Injunction was entered by the United States District Court for the District of Hawaii on December 8, 1987, in *General Conference Corporation of Seventh-Day Adventists v. Seventh-Day Adventist Congregational Church, et al.*, Civ. No. 87-274, which was not published. A copy is attached hereto as Appendix A.

An Order Denying Defendants' Motion to Set Aside Judgment, to Dismiss or for New Trial, for More Definite Statement, and to Strike was entered by the United States District Court for the District of Hawaii on March 16, 1988, in *General Conference Corporation of Seventh-Day Adventists v. Seventh-Day Adventist Congregational Church, et al.*, Civ. No. 87-274, which was not published. A copy is attached hereto as Appendix B.

An Order Holding Defendants in Contempt of Judgment and Permanent Injunction was entered by the United States District Court for the District of Hawaii on May 12, 1988, in *General Conference Corporation of Seventh-Day Adventists v. Seventh-Day Adventist Congregational Church, et al.*, Civ. No. 87-274, which was not published. A copy is attached hereto as Appendix C.

An Opinion by Judge Canby for the United States Court of Appeals for the Ninth Circuit was filed on October 5, 1989 in *General Conference Corporation of Seventh-Day Adventists v. Seventh-Day Adventist Congregational Church, et al.*, No. 88-2506, which has not yet been published. A copy is attached hereto as Appendix D.

2. STATEMENT OF THE CASE

2.1 *Statement Of Facts*

Respondent General Conference Corporation of Seventh-day Adventists ("the General Conference") is the undisputed exclusive owner of its incontestable U.S. Trademark and Service Mark Registration No. 1,177,185 registered November 10, 1981 for the name "SEVENTH-DAY ADVENTIST" used in

connection with its ministry, services, advertising, activities, products, and goods. The registration will remain in full force and effect until November 10, 2001. On June 16, 1987, the U.S. Patent and Trademark Office issued official notice confirming acceptance of the Section 8 and 15 Affidavits for Registration No. 1,177,185 and fulfillment of all statutory requirements by the General Conference with respect to such registration, thereby rendering the registration incontestable.

The General Conference is the first legal user of its exclusive trade name, trademark, and service mark "SEVENTH-DAY ADVENTIST" in interstate commerce continuously from 1860 to present date for the goods and services recited in Registration No. 1,177,185. The General Conference first used its exclusive trade name, trademark, and service mark "SEVENTH-DAY ADVENTIST" for its ministry, churches, services, activities, instructions, goods, products, and advertising prior to any use of the name by Petitioners John R. Marik ("Marik") and Seventh-day Adventist Congregational Church ("SDACC").

Without the consent of the General Conference, Petitioners Marik and SDACC have adopted and commercially used the General Conference's registered name, trademark, and service mark "SEVENTH-DAY ADVENTIST" in their church, ministry, services, advertising, activities, instructions, products, and goods in Hawaii. This infringing use of "SEVENTH-DAY ADVENTIST" by Petitioners continues to this date.

2.2 *Procedural Background*

The General Conference filed a Complaint asserting claims for trademark infringement, unfair competition, and injunctive relief on April 9, 1987. Marik and SDACC filed an Answer to the Complaint on May 18, 1987. Counsel for the General Conference notified Marik on behalf of himself and SDACC that Defendants' Answer was not in compliance with the Federal Rules of Civil Procedure and was subject to being struck or deemed an admission of the allegations in the Complaint. The General Conference offered to give (and subsequently allowed) Petitioners an extension of time to file an amended

answer by June 15, 1987. Marik and SDACC did not file an amended answer by the June 15, 1987 deadline.

On July 15, 1987, a Motion for Judgment on the Pleadings, or in the Alternative, Motion to Strike was filed by the General Conference and served upon Marik and SDACC. The motion was set for hearing on September 8, 1987 before Judge Roger Foley.

On August 4, 1987, Petitioners filed a pleading entitled "Denial of Plaintiff's Allegations and Appeal to the Court on Behalf of Defendant." On August 19, 1987, Petitioners filed a pleading entitled "Answer to the Complaint and an Appeal to the Court on Behalf of Defendants and the Answer and Denial of the Complaint." Marik and SDACC also filed a Scheduling Conference Statement on September 3, 1987. No other pleadings were filed by Petitioners in response to the Motion for Judgment on the Pleadings, or in the Alternative, Motion to Strike.

On September 1, 1987, the parties were notified that Plaintiff's motion for judgment on the pleadings was granted. Plaintiff's alternative motion to strike was denied on the merits. The Order Granting Motion for Judgment on the Pleadings and Denying Motion to Strike was entered by Judge Roger Foley on September 24, 1987. On December 8, 1987 the court entered the Judgment and Permanent Injunction in favor of the General Conference and against Marik and SDACC. Appendix A.

On December 28, 1987, Marik and SDACC filed a Motion for Suspension of Injunction and Order Pending Hearing and Ruling on Motion to Set Aside Judgment, to Dismiss or for New Trial, for a More Definite Statement, and to Strike Under FRCP 59 and FRCP 12 and Motion to Set Aside Judgment, to Dismiss or for New Trial, for a More Definite Statement, and to Strike Under FRCP 59 and FRCP 12. A hearing on the Motion was held before Judge Russell Smith on February 22, 1988, and on March 16, 1988 the court entered its Order Denying the Motion. Appendix B.

In the meantime, on January 12, 1988, Marik and SDACC filed their Compliance Report which unequivocally admitted

(1) continued use of the General Conference's registered mark "SEVENTH-DAY ADVENTIST" in connection with Defendants' church services and activities associated therewith; and (2) continued possession of a sign, literature, and other SDACC produced materials bearing the name "SEVENTH-DAY ADVENTIST" in violation of the Judgment and Permanent Injunction entered on December 8, 1987. Consequently, on February 1, 1988, the General Conference filed and served upon Petitioners its Motion for Order to Show Cause Why Defendants Should Not be Held in Contempt Because of Defendants' Violation of Judgment and Permanent Injunction.

An Order to Show Cause Why Defendants Should Not be Held in Contempt was entered on April 20, 1988. A full hearing on the order to show cause took place on May 9, 1988 before Judge Dickran Tevrizian. At the May 9, 1988 hearing, the court found Marik and SDACC in contempt of the Judgment and Permanent Injunction. However, the court allowed Defendants a three day grace period to comply with the outstanding Judgment and Permanent Injunction before the court's order would be entered. Marik and SDACC refused to do so and the Order Holding Defendants in Contempt of Judgment and Permanent Injunction was entered on May 12, 1988. Appendix C.

Petitioners filed a Notice of Appeal on April 7, 1988, prior to the hearing on the order to show cause, only appealing from the December 8, 1987 Judgment and Permanent Injunction and the March 16, 1988 Order Denying Defendants' Motion to Set Aside Judgment. Appendix E. Subsequent to the filing of their Notice of Appeal, Marik and SDACC never sought a stay of the judgment pending appeal from either the District Court or the Court of Appeals under Fed. R. Civ. Pro. 62 or Fed. R. App. Pro. 8. Marik and SDACC also failed to amend their Notice of Appeal or file a new notice of appeal to appeal from the contempt order pursuant to Fed. R. App. Pro. 3 and 4.

Marik and SDACC have never filed an appeal from the May 12, 1988 Order Holding Defendants in Contempt. On appeal before the Ninth Circuit, Marik and SDACC devoted three sentences in their Brief for Appellants, p. 36, to an argument that the District Court's refusal to hear certain evidence during

the order to show cause hearing deprived them of procedural due process. Appendix F. This was the first time the argument was made by Petitioners. They raised the argument again in a paragraph in their Reply Brief of Appellants, p. 17. Appendix G.

On appeal, the Ninth Circuit Court held that Marik and SDACC had raised issues of material fact or presented affirmative defenses to preclude the judgment on the pleadings. The judgment was reversed and the case was remanded to the district court for further proceedings. Appendix D. However, the Court of Appeals pointed out that the contempt order had not been brought before it and declined to rule upon Marik and SDACC's attempt to challenge the contempt order. *Id.* The Court explained that relief in this regard must come from the District Court. *Id.* The Ninth Circuit issued its decision on October 5, 1989. *Id.*

Since then, Marik and SDACC have not attempted to seek relief from the contempt order in the District Court despite the Court of Appeals' suggestion that they do so and despite the remand of this case back to the District Court. Had Petitioners moved in the District Court to set aside the contempt order in October, the matter would have been resolved by now. Petitioners' counsel in fact refuses to seek relief at the District Court level. (*See* Mr. Max Corbett's letter to Chief Judge Harold M. Fong, dated January 12, 1990, Appendix H, and Ms. Lorraine H. Akiba's letter to Chief Judge Harold M. Fong, dated January 8, 1990, Appendix I.)

Instead, Petitioners insist upon pursuing this issue through certiorari review, thereby complicating the matter and delaying the proceedings below. However, it should be noted that after being apprehended on December 15, 1989, Marik was released from custody on December 20, 1989.

3. **SUMMARY OF ARGUMENT**

Petitioners cite two reasons for certiorari review: (1) the Court of Appeals' decision conflicts with the decision of another federal court; and (2) the Court of Appeals has so far departed from the accepted and usual course of judicial proceedings. However, Petitioners have not demonstrated such

grounds from the decision and record below. In support of their contentions, Petitioners cite decisions from state courts and fail to explain how the Court of Appeals decision conflicts with or departs from federal law. Furthermore, the Court of Appeals has not ruled in any manner adverse to the authorities cited by Petitioners. It instead reversed a judgment against Petitioners and remanded the case to the District Court for further proceedings.

Because this case has been remanded, it is not ripe for certiorari review. Petitioners also improperly seek certiorari review of a District Court contempt order which was never brought before the Court of Appeals. The Court of Appeals did not rule upon the order because Petitioners have never filed an appeal from the order.

Petitioners also would have this Court take judicial notice of extrinsic and irrelevant facts never made part of the record below. Judicial notice by the Supreme Court of facts raised for the first time on appeal would be totally contrary to the Supreme Court's task during certiorari review, that being to review factual findings from the lower courts rather than to determine facts *de novo* like a trial court. This is also unnecessary, because Petitioners may still attempt to introduce such alleged "facts" to the District Court on remand.

4. ARGUMENT

4.1 *The Court of Appeals Has Not Rendered A Decision In Conflict With The Decision of Another Federal Court Or Which So Far Departed From The Accepted And Usual Course Of Judicial Proceedings*

Rule 17, Rules of the Supreme Court of the United States, provides: "A review on writ of certiorari is not a matter of right, but of judicial discretion, and will be granted only when there are special and important reasons therefor." Rule 17 further sets forth examples to indicate the character of reasons that will be considered, and Petitioners, in the section of its Petition under the heading *"REASONS FOR GRANTING THE WRIT,"* cite two of those as *the* reasons for granting a writ of certiorari in this case. First, Petitioners contend that the decision below conflicts with the tenor of decisions of the Supreme

Court and other federal courts. Second, they contend that the decision below has so far deviated from the accepted and usual course of judicial proceedings.

However, Petitioners then proceed to repeat their arguments made before the Court of Appeals without any discussion of how the court's decision either conflicts with the tenor of decisions of other federal courts or deviates from the accepted and usual course of judicial proceedings. The only exception occurs at page 21 of the Petition where Petitioners argue that until the present case there was unanimity in all federal circuit courts with regard to the review of a civil contempt order on appeal. (The decision on the contempt order shall be addressed more particularly, *infra*.)

A review of the sources of Petitioners' authorities relied upon in support of their arguments reveals that the Court of Appeals has not rendered a decision which conflicts with or deviates from federal law. For instance, Petitioners' argument that the Court of Appeals erred in refusing to take judicial notice of voluminous religious documentary evidence is grounded on *state* court decisions in which certain religious matters were judicially noticed. Petition, p. 10. Similarly, Petitioners' argument that the trademark, trade name and service mark at issue in this case is a generic term relies on a decision of the New Jersey Supreme Court. Petition, p. 12. Petitioners' argument that they are entitled under guarantees of freedom of religion and speech to use "Seventh-day Adventist" is also supported by citations to state court decisions. Petition, p. 13. This legal deficiency in demonstrating any alleged conflict with federal law prevails throughout the entire Petition.

Furthermore, the Court of Appeals did not decide anything contrary to the authorities cited by Petitioners, whether the authorities be state or federal authorities. The Court of Appeals' holdings are summarized by it as follows:

> [1] A judgment on the pleadings is a decision on the merits and it is reviewed de novo. [2] Defendants filed two pleadings which the district court construed as "answers." If these "answers" are construed liberally because Marik

> submitted them pro se, they set forth two points that either raise questions of material fact or present affirmative defenses. [3] Defendants claimed that the name Seventh Day Adventist is generic because it refers to a religion rather than the church organization. Defendants are not liable for trademark infringement if they prove that the mark is generic. Because this defense was raised in the answer, it bars a judgment on the pleadings. [4] Also in the answer, Marik made several factual assertions regarding the likelihood of confusion, and these factual allegations create a material issue of fact that should not have been determined in a judgment on the pleadings.

Appendix D. These are the legal pronouncements that the appellate court's decision stood for. Petitioners did not cite a single authority to challenge any of the above.

The Court of Appeals' decision could be construed as favorable to Petitioners, for it reversed the District Court's Judgment against Petitioners. The Court of Appeals did not make any determination as to the merits of the authorities cited in the Petition, rather it remanded the case. Nor did it cite or create any law contrary to any authorities relied upon by Petitioners.

Therefore, this is not a case where a federal court of appeals has rendered a decision in conflict with the decision of another federal court or so far departed from the usual course of judicial proceedings. Accordingly, the Petition should be denied.

4.2 *This Case Is Not Ripe For Certiorari*

Petitioners have not established any grounds for certiorari review to be invoked in this case. Similarly, this Court denied a petition for certiorari in *Brotherhood of Locomotive Firemen and Enginemen v. Bangor & Aroostook Railroad Company*, 389 U.S. 327 (1967), which involved an appeal from a contempt order of the United States District Court for the District of Columbia entered against the Brotherhood of Locomotive Firemen and Enginemen. The Court of Appeals for the District of Columbia Circuit ruled on some legal issues and remanded to the district court for determination of others. The union petitioned this Court for certiorari to review the adverse rulings made by the D.C. Circuit Court. This Court denied the petition

on the grounds that "because the Court of Appeals remanded the case, it is not ripe for review by this Court." *Id.*, 389 U.S. at 328.

The instant case is even less ripe for certiorari review than was *Brotherhood of Locomotive Firemen, supra*, where the D.C. Circuit Court had made some rulings adverse to the petitioner. The Ninth Circuit Court has merely remanded the case to the District Court for further adjudication on the merits. While the Court of Appeals refused to take judicial notice of purported "facts" raised for the first time on appeal and to rule on the contempt order which was never appealed, it did not preclude the District Court upon remand from taking judicial notice or from providing Petitioners' relief from the contempt order. Moreover, the Petitioners had and still have adequate opportunity to seek relief and a remedy below in the District Court, which they repeatedly and intentionally refuse to do. Therefore, this case is not ripe for certiorari review.

4.3 *This Court Should Not Review The Contempt Order Because That Order Was Not Appealed And Not Addressed By The Court Of Appeals*

This Court has held that it will not review matters not raised in the court of appeals and not addressed by that court. *Rogers v. Lodge*, 458 U.S. 613, 628 n. 10 (1982). In this case, the May 12, 1988 contempt order of the District Court was not appealed to the Court of Appeals. Petitioners failed to file any notice of appeal stating that they were appealing from the contempt order as required by Fed. R. App. Pro. 3. For that very reason, the Court of Appeals refused to rule on the contempt order. Accordingly, it would be improper for this Court to review the contempt order.

Petitioners cite a string of cases in support of the proposition that "[a]n order of civil contempt is reviewable on an appeal taken from the final judgment in the suit out of which the contempt proceedings arose." Petition, p. 21. Petitioners argue that the Court of Appeals' refusal to rule on the contempt order in this case is contrary to the cited cases. However, the cited cases all involve the question of whether a civil contempt order can be appealed from *before* a final judgment in the case, and

those cases hold that a civil contempt order is interlocutory and cannot be filed until there has been a final judgment. That is an entirely different issue from Petitioners' suggestion that the civil contempt order must be considered during an appeal of the final judgment, regardless of whether the order has been specifically appealed from.

Only one of those cases cited by Petitioners, *Halderman v. Pennhurst State School & Hospital*, 673 F.2d 628 (3rd Cir. 1982), actually involves circumstances similar to this case, and the court ruling on the matter was consistent with the Court of Appeals in this case. In *Halderman*, as in this case, a contempt order had been entered by a district court *after* a permanent injunction had been entered and appealed from. The Third Circuit Court of Appeals held that the contempt order was properly appealable. *Id.* at 636. Thus, contrary to Petitioners' contentions, it is not necessary that a civil contempt order be reviewed simultaneously with an appeal of the judgment upon which the contempt order is based. Where the contempt order is entered after the final judgment has been appealed from, the proper procedure is for the party to file a separate appeal from the contempt order. Because Petitioners knowingly and intentionally failed to appeal from the contempt order in this case, the Court of Appeals was correct in refusing to rule on the order.

Furthermore, Petitioners are not without available avenues of relief from the contempt order. The case has been remanded to the District Court where Petitioners are free to move to set aside the order. There is no reason why this Court's time and resources should be expended on a matter which may be resolved at the district court level through a simple motion.

4.4 *The Petitioners Have Introduced Evidence Which Was Not Before The Courts Below*

Petitioners submit evidence in their Petition for Writ of Certiorari which was never presented to the District Court nor the Court of Appeals. The following is a list of publications from which the Petitioners have gleaned statements in support of their arguments and alleged as "established facts":

A New English Dictionary on Historical Principals, Henry Bradley, 1914 ed.

New Werner Twentieth Century Edition of Encyclopedia Britannica, Vol. 25, 1905 ed., p. 52

Seventh-day Adventist Encyclopedia, 10 ed., pp. 1179, 435

The Encyclopedia Americana, Vol. 24, 1972 ed., p. 620

The Encyclopedia of American Religions, 2nd ed. 1987, J. Gordon Melton, pp. 77, 79-81

The Westminister Dictionary of Church History, Jerald C. Brauer, 1971 ed., pp. 763, 764

Universal Dictionary of the English Language, Robert Hunter and Charles Morris, 1987 ed.

The World Book Encyclopedia, Vol. 17, 1989 ed., p. 326

A History of Churches in the United States and Canada, Robert T. Handy, 1977 ed., pp. 194-196, 294, 374

Bible: John 14:3 NKJ; Revelation 14:9-12 NKJ; Revelation 16:1,2 NKJ

Seventh-day Adventist Renounced, D.M. Canright, 1889 ed., pp. 25, 20, 21

Houston Chronicle, Sunday, September 24, 1989, p. 21A

None of the alleged "evidence" presented from these sources has been established, authenticated, or otherwise verified as required by Fed. R. Evid. 201 and Fed. R. Civ. Pro. 56(e) to allow judicial notice of such alleged facts. Accordingly, the Court of Appeals properly refused to take judicial notice of such alleged facts.

Petitioners would now have this Court grant certiorari on the basis of evidence that has never been before the lower courts, and then presumably would have this Court engage in *de novo* fact finding like a trial court. However, this would be contrary to the Supreme Court's task during certiorari review: "'[O]ur task is limited.' [Citation omitted.] It is not for us to pass upon the myriad factual and legal issues as though we

were trying this case de novo." *New York, NH&H Railroad Co. First Mortgage 4% Bondholders Committee v. United States*, 399 U.S. 392, 435 (1970).

Accordingly, it would be improper for this Court to make the kind of review that Petitioners seek.

4.5 *Certiorari Review Of The Court of Appeals' Refusal To Take Judicial Notice Of Proposed Facts Raised For The First Time On Appeal Is Unwarranted*

Petitioners had argued to the Court of Appeals that the court should take judicial notice of an extensive number of documents and publications, which the Court of Appeals correctly declined to do. Petitioners now argue that it was error not to take judicial notice. Regardless of the merits of such arguments, it is not necessary for this Court to decide whether the proposed facts should have been judicially noticed because this case has been remanded to the District Court. Petitioners will have ample opportunity to seek introduction of that evidence properly at the trial level. Furthermore, Petitioners are not precluded from moving the District Court to take judicial notice.

In effect Petitioners are asking this Court to make factual determinations and to take judicial notice of facts like a trial court before Petitioners have attempted to introduce those facts in the remanded proceedings at the district court level. The question of judicial notice is properly one for the trial court to consider. For this Court to review the judicial notice question now would amount to an unjustified departure from normal appellate procedure and improper fact finding outside the scope of appellate review.

5. CONCLUSION

For all the reasons set forth herein, the General Conference submits that the Petition for Writ of Certiorari should be denied.

Respectfully submitted, this 8th day of February, 1990.

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IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF HAWAII

GENERAL CONFERENCE CORPORATION OF SEVENTH-DAY ADVENTISTS,	) CIVIL NO. 87-274
	) JUDGMENT AND PERMANENT INJUNCTION
Plaintiff,	)
vs.	)
SEVENTH-DAY ADVENTIST CONGREGATIONAL CHURCH, and JOHN R. MARIK,	)
Defendants.	)

JUDGMENT AND PERMANENT INJUNCTION

Pursuant to the Order Granting Motion for Judgment on the Pleadings, and Denying Motion to Strike entered herein on September 24, 1987 and based upon the pleadings and other papers filed herein, judgment as to all matters alleged in the Complaint is hereby entered in favor of Plaintiff GENERAL CONFERENCE CORPORATION OF SEVENTH-DAY ADVENTISTS and against Defendants SEVENTH-DAY ADVENTISTS CONGREGATIONAL CHURCH and JOHN R. MARIK.

The Court hereby further orders, adjudges and decrees that Defendants SEVENTH-DAY ADVENTISTS CONGREGATIONAL CHURCH and JOHN R. MARIK, and each of them, and all of the their agents, servants, employees and attorneys, and all persons in active concert or participation with them (hereinafter collectively referred to as the "Defendants") are PERMANENTLY ENJOINED AND RESTRAINED:

(a) from using, promoting, advertising, imitating, copying or in any way displaying any name or mark that includes the term "SEVENTH-DAY ADVENTIST", or any term that is confusingly similar to "SEVENTH-DAY ADVENTIST", or is a simulation, reproduction, counterfeit, copy, colorable imitation, abbreviation (including, without limitation, the abbreviation "SDA" and any colorable imitations of "SDA"), or other designation thereof, in connection with the offering, promotion, advertising or rendering of services or the sale or distribution of any literature or other goods, or in connection with any other activity, in a manner likely to cause confusion, or to cause mistake or to deceive;

(b) from using the term "SEVENTH-DAY ADVENTIST", or any term that is confusingly similar to "SEVENTH-DAY ADVENTIST", or is a simulation, reproduction, counterfeit, copy, colorable imitation, abbreviation (including, without limitation, the abbreviation "SDA" and any colorable imitations of "SDA"), or other designation thereof, in any trade name or corporate name of any entity controlled by the Defendants, or by any of them, and specifically from retaining the term

"SEVENTH-DAY ADVENTIST" or "SDA" in the name of the Defendants' church services, or in any offering, promotion, advertising or rendering of such services;

(c) from reproducing, counterfeiting, copying or colorably imitating the mark "SEVENTH-DAY ADVENTIST" and applying such reproduction, counterfeit, copy or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive;

(d) from using any false designation of origin or false description, or representation, or performing any act, which can, or is likely to, lead the public or any individual members thereof, to believe that the Defendants' services are in any manner associated, affiliated or connected with Plaintiff's services, or that Plaintiff sponsors, approves or authorizes the Defendants' services;

(e) from representing or in any way suggesting or implying that the church services of the Defendants are in any manner associated, affiliated or connected with Plaintiff's church services, or that Plaintiff sponsors, approves or authorizes Defendants' church services;

(f) from representing or in any way suggesting or implying that any of the services, literature, products or goods of Defendants are in any manner associated or connected with Plaintiff's "SEVENTH-DAY ADVENTIST" services, literature, products or goods, or that Plaintiff sponsors, approves or authorizes Defendants' services, literature, products or goods;

(g) from making any other false or misleading representation with respect to the authenticity or standard or nature of either Plaintiff's or Defendants' services or goods;

(h) from applying for or registering any service mark, trademark, trade name, certification mark or collective mark that is a reproduction, simulation, counterfeit, copy, colorable imitation, abbreviation (including, without limitation, the

abbreviation "SDA" and any colorable imitations of "SDA"), or other designation of Plaintiff's "SEVENTH-DAY ADVENTIST" mark with any governmental entity;

(i) from engaging in any other activity constituting an infringement of Plaintiff's service mark, trademark and trade name "SEVENTH-DAY ADVENTIST", or of Plaintiff's rights in and to such service mark, trademark and trade name;

(j) from engaging in any other activity constituting unfair competition with Plaintiff or constituting unfair or deceptive trade practices;

(k) from creating any confusion as to source, sponsorship or approval as to the Plaintiff's or the Defendants' services and goods; and

(l) from taking any actions that may injure Plaintiff's goodwill and reputation by way of imitation, misrepresentation, advertising, fraud, passing off or deception.

DEFENDANTS ARE HEREBY ORDERED:

(a) to deliver up to Plaintiff for destruction all labels, signs, prints, advertising materials, literature, packages, wrappers and other materials in the possession or custody of the Defendants, or any of them, or under their control, bearing the term "SEVENTH-DAY ADVENTIST", or any term that is confusingly similar to "SEVENTH-DAY ADVENTIST", or is a simulation, reproduction, counterfeit, copy, colorable imitation, abbreviation (including, without limitation, the abbreviation "SDA" and any colorable imitations of "SDA"), or other designation thereof, and all plates, molds, matrices and other means of making the same; and

(b) to file with this Court and to serve on the Plaintiff within thirty (30) days after service of this Judgment and Permanent Injunction, a written report under oath setting forth in detail the manner and form in which the Defendants have complied with this injunction.

DATED: Honolulu, Hawaii; November 30, 1987.

(S) Roger D. Foley

Judge of the Above-Entitled Court

[GENERAL CONFERENCE CORPORATION OF SEVENTH-DAY ADVENTISTS v. SEVENTH-DAY ADVENTIST CONGREGATIONAL CHURCH AND JOHN R. MARIK, CIVIL NO. 87-274; Judgment and Permanent Injunction]

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF HAWAII

GENERAL CONFERENCE CORPORATION OF SEVENTH-DAY ADVENTISTS, *Plaintiff,* vs. SEVENTH-DAY ADVENTIST CONGREGATIONAL CHURCH and JOHN R. MARIK, *Defendants.*	CIVIL NO. 87-0274 ORDER DENYING DEFENDANTS' MOTION TO SET ASIDE JUDGMENT, TO DISMISS OR FOR NEW TRIAL, FOR A MORE DEFINITE STATEMENT, AND TO STRIKE

ORDER DENYING DEFENDANTS' MOTION TO SET ASIDE JUDGMENT, TO DISMISS OR FOR NEW TRIAL, FOR A MORE DEFINITE STATEMENT, AND TO STRIKE

Initially I thought that the motions were untimely. I was wrong in that, and now address the merits of the defendants' motions.

Plaintiff is a corporation organized under the laws of the District of Columbia. Defendant Marik is an individual and defendant Seventh Day Adventist Congregational Church is a non-profit religious corporation organized under the laws of Hawaii.

The complaint, which seeks to protect a trade name, alleges that the plaintiff is the owner of an incontestable trade mark for the name "Seventh Day Adventist" registered, November 10, 1981, U. S. Trademark and Service Mark registration No. 1,177,185 for use in connection with its religious activities. The complaint alleges that the trade mark has been used by the plaintiff since 1860 continuously, worldwide; that the ministry conducts services in 200 countries, has 4,500,000 members, 25,000 churches, and 10,000 ordained ministers; that long after the plaintiff's first use of the trade-name, the defendants, without plaintiff's consent, commenced a ministry using the name "Seventh-Day Adventist", which is likely to cause confusion in the minds of the public.

The complaint was filed April 9, 1987.

On May 18, 1987, Marik (who is not admitted to practice in this court), filed a paper in behalf of himself and the defendant church. The paper filed is not responsive to the complaint. It does not deny that the plaintiff has the registered trade name and does not deny its first use. It states that the defendants do not intend to cause confusion and that they find strange the idea that a church and its message should be a business.

The plaintiff, on July 15, 1987, filed a motion for judgment on the pleadings and noticed it for hearing on September 8, 1987. There was no response to the motion, but a paper was filed on August 4, 1987, called a "Denial of Plaintiff's Allega-

tions". The denial does not deny any of the facts stated in the complaint. It does argue that religious issues have no relevance to the purposes of the court; that religious activities are not subject to secular laws; and that the defendants have no lawyer because that don't think God would want them to. On September 3, Marik filed another paper stating that it is a violation of "our" conscience to enter into litigation because "by doing so our Lord would not be glorified".

On this state of the record and at the time noticed for the hearing, Judge Foley granted the Motion for Judgment on the Pleadings (not, as defendant contends, a motion for summary judgment) and subsequently entered a judgment enjoining the defendants from using the name.

As I see it, Judge Foley took the view that the words "Seventh-Day Adventist" could be a trade name subject to registration, and that the plaintiff's use of the words "Seventh-Day Adventist Congregationalist Church" was apt to be misleading. This approach to the problem was taken in the case of *Purcell v. Summers*, 145 F.2d 959 (4th Cir. 1944). In the approach taken by the Supreme Court of New Jersey in the case of *Christian Science Bd. of directors v. Evans*, 520 A.2d 1347, 105 N.J. 297 (N.J. 1987), the words "Seventh-Day Adventist" would be treated as generic and, if so treated, could not be appropriated as a trade mark. They could be used by anyone practicing the Seventh-Day Adventist faith.

I think that there is but one question here; that it is a question of law, and that Judge Foley has decided it.

As I see it, there are no grounds upon which the judgment should be set aside. I think the court had jurisdiction, that the complaint did state a claim, and that there was no fatal non joinder. The proceedings leading to the judgment in the pleadings cannot be faulted. A new trial might be granted on the ground that the district court was wrong.

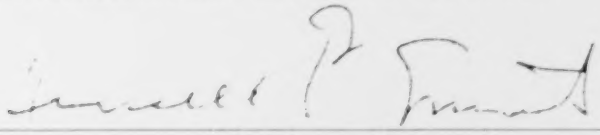
I do not believe that by making a motion for new trial instead of taking an appeal a party should be able to require a district judge to perform the functions of the Court of Appeals.

The Motions are each and all DENIED. The Motion for sanctions is DENIED, without prejudice. The problem of sanc-

tions can be considered after the judgment has become final on appeal.

IT IS SO ORDERED.

DATED: Honolulu, Hawaii, March 16, 1988.



UNITED STATES DISTRICT JUDGE

GENERAL CONFERENCE CORPORATION OF SEVENTH-DAY ADVENTISTS v. SEVENTH-DAY ADVENTIST CONGREGATIONAL CHURCH, ET AL., CIVIL NO. 87-0274—DENIAL OF MOTION TO SET ASIDE JUDGMENT, TO DISMISS OR FOR NEW TRIAL, FOR A MORE DEFINITE STATEMENT, AND TO STRIKE.

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**IN THE UNITED STATES DISTRICT
FOR THE DISTRICT OF HAWAII**

GENERAL CONFERENCE CORPORATION OF SEVENTH-DAY ADVENTISTS,	)	CIVIL ACTION NO. 87-274
Plaintiff,	)	
vs.	)	ORDER HOLDING DEFENDANTS IN CONTEMPT OF THE JUDGMENT AND PERMANENT INJUNCTION
SEVENTH-DAY ADVENTIST CONGREGATIONAL CHURCH, and JOHN R. MARIK,	)	
Defendants.	)	
_____	)	

ORDER HOLDING DEFENDANTS IN CONTEMPT OF THE JUDGMENT AND PERMANENT INJUNCTION

On April 20, 1988, the Court issued an Order to Show Cause Why Defendants Should Not Be Held in Contempt Because of Defendants' Violation of Judgment and Permanent Injunction. The order to show cause came on for hearing before the Honorable Dickran Tevrizian, Jr. on May 9, 1988 at 9:00 o'clock, a.m. Defendants SEVENTH-DAY ADVENTIST CONGREGATIONAL CHURCH and JOHN R. MARIK were represented by their counsel, Max A. Corbett, and Plaintiff GENERAL CONFERENCE CORPORATION OF SEVENTH-DAY ADVENTISTS was represented by its counsel, Lorraine H. Akiba.

The Court having read the written memoranda and other pleadings of counsel for Plaintiff and Defendants, having heard the oral arguments of counsel, having considered the affidavits and arguments in response to the order to show cause, and being fully advised and familiar with the entire record of the case, finds and holds as follows:

The Judgment and Permanent Injunction entered herein on December 8, 1987 ordered Defendants to immediately cease and desist from using, promoting, advertising, imitating, copying, or displaying the service mark, trademark, and trade name "Seventh-Day Adventist" and to deliver to Plaintiff for destruction all labels, signs, prints, advertising materials, literature, packages, wrappers, and other materials in the possession of the Defendants, or any of them, or under their control, bearing the term "Seventh-Day Adventist," or any term that is confusingly similar to "Seventh-Day Adventist," or is a simulation, reproduction, counterfeit, copy, colorable imitation, abbreviation (including, without limitation, the abbreviation "SDA" and any colorable imitations of "SDA"), or other designation thereof, and all plates, molds, matrices, and other means of making the same. Defendants were also ordered to file with the Court and to serve on Plaintiff within 30 days of the Judgment date a written report under oath setting forth in detail

the manner and form in which the Defendants complied with the injunction. The Judgment and Permanent Injunction is a valid order signed by United States District Judge Roger Foley and remains in full force and effect.

On January 8, 1988, Defendants filed a Compliance Report which expressly stated that they are continuing to use the name "Seventh-Day Adventist" and to have in their possession signs, literature, and other materials bearing the trademark name "Seventh-Day Adventist" which have not been delivered to Plaintiff in willful violation of the Permanent Injunction.

Defendants also stated that they were advised by their attorney that pursuant to the provisions of 15 U.S.C. § 1116(a), the Judgment and Permanent Injunction entered on December 8, 1987 could be enforced by "proceedings to punish for contempt, or otherwise." Defendants reiterated that they fully recognized and understood that the punishment for their willful and conscious non-compliance with the injunction could result in their commitment to jail and the imposition of such other penalties as the Court may deem just and proper.

It is undisputed from the records and files in this case that Defendants have failed to comply with the Judgment and Permanent Injunction. Defendants have unequivocally stated that they continue to violate this Court's orders.

The Court holds that Defendants SEVENTH-DAY ADVENTIST CONGREGATIONAL CHURCH and JOHN R. MARIK, individually and collectively, are in violation of the Judgment and Permanent Injunction entered herein on December 8, 1987. The Court holds Defendants, individually and collectively, in civil contempt of court by reason of their willful violation of this Court's Judgment and Permanent Injunction. Pursuant to 18 U.S.C. § 401, the Court imposes a fine of $500.00 per day against Defendant SEVENTH-DAY ADVENTIST CONGREGATIONAL CHURCH, individually and collectively; and a fine of $500.00 per day against Defendant JOHN R. MARIK, individually and collectively, until full compliance with the Judgment and Permanent Injunction by said Defendants is obtained. Defendants are ordered to pay such fines to the Clerk of the Court until full compliance is obtained.

The Court further orders that with respect to Defendant JOHN R. MARIK, individually and as the President of Defendant SEVENTH-DAY ADVENTIST CONGREGATIONAL CHURCH, a warrant shall be issued for his arrest until full compliance with the Judgment and Permanent Injunction by Defendants is obtained. The arrest warrant will be issued and effective immediately upon the date this order is signed.

The Court also awards to Plaintiff and against Defendants SEVENTH-DAY ADVENTIST CONGREGATIONAL CHURCH and JOHN R. MARIK, individually and collectively, the amount of $13,929.21 for reasonable attorneys' fees and costs incurred by Plaintiff herein.

IT IS SO ORDERED.

DATED: Honolulu, Hawaii, May 12 1988.

DICKRAN TEVRIZIAN, JR.

UNITED STATES DISTRICT JUDGE

[GENERAL CONFERENCE CORPORATION OF SEVENTH-DAY ADVENTISTS v. SEVENTH-DAY ADVENTIST CONGREGATIONAL CHURCH, et al.; CIVIL NO. 87-274—ORDER HOLDING DEFENDANTS IN CONTEMPT OF JUDGMENT AND PERMANENT INJUNCTION]

FOR PUBLICATION
UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

GENERAL CONFERENCE CORPORATION OF SEVENTH-DAY ADVENTISTS,
Plaintiff-Appellee,
v.
SEVENTH-DAY ADVENTIST CONGREGATIONAL CHURCH; JOHN R. MARIK,
Defendants-Appellants.

No. 88-2506
D.C. No. CV-87-0274 RES
OPINION

Appeal from the United States District Court
for the District of Hawaii
Russell E. Smith, Senior District Judge, Presiding

Argued and Submitted
May 11, 1989—San Francisco, California

Filed October 5, 1989

Before: Procter Hug, Jr., Mary M. Schroeder and William C. Canby, Jr., Circuit Judges.

Opinion by Judge Canby

SUMMARY

Copyright, Patent and Trademark/Courts and Procedure

Reversing and remanding the district court's judgment, the court held that a judgment on the pleadings is improper where a defendant either raises questions of material fact or presents affirmative defenses.

Defendants Seventh-Day Adventist Congregational Church and John Marik appealed a judgment on the pleadings and the issuance of a permanent injunction against them in a trademark infringement action. Plaintiff General Conference Corporation of Seventh-Day Adventists brought a claim against defendants under the Lanham Act, 15 U.S.C. § 1051 et seq., for trademark and service mark infringement, unfair competition, and false designation of origin. Marik, pro se, and allegedly on behalf of the Congregational Church, filed a response and a denial of plaintiff's allegations. Because defendants filed no response to plaintiff's motion for judgment on the pleadings, the district court ordered that it be granted. Defendants' motion to set aside the judgment was denied, and defendants appealed.

[1] A judgment on the pleadings is a decision on the merits and it is reviewed de novo. [2] Defendants filed two pleadings which the district court construed as "answers." If these "answers" are construed liberally because Marik submitted them pro se, they set forth two points that either raise questions of material fact or present affirmative defenses. [3] Defendants claimed that the name Seventh Day Adventist is generic because it refers to a religion rather than the church organization. Defendants are not liable for trademark infringement if they prove that the mark is generic. Because this defense was raised in the answer, it bars a judgment on the pleadings. [4] Also in the answer, Marik made several factual assertions regarding

the likelihood of confusion, and these factual allegations create a material issue of fact that should not have been determined in a judgment on the pleadings.

COUNSEL

Max A. Corbett and Peter N. Fowler, Annandale, Virginia, for the defendants-appellants.

Lorraine H. Akiba, Honolulu, Hawaii, for the plaintiff-appellee.

OPINION

CANBY, Circuit Judge:

Defendants Seventh-Day Adventist Congregational Church and John Marik appeal a judgment on the pleadings and the issuance of a permanent injunction against them in a trademark infringement action. We reverse and remand for further proceedings.

BACKGROUND AND PROCEEDINGS BELOW

The General Conference Corporation of Seventh-Day Adventists sued the Seventh-Day Adventist Congregational Church, located in Kealakekua, Hawaii, and its paster, John R. Marik, under the Lanham Act, 15 U.S.C. § 1051 et seq., for trademark and service mark infringement, unfair competition, and false designation of origin. The General Conference also asserted claims under the common and statutory law of Hawaii relating to trademarks, service marks, trade names, unfair competition, deceptive trade practices, and false advertising. The complaint was filed on April 9, 1987. Marik, pro se, and allegedly on behalf of the Congregational Church, filed

a response on May 18, 1987. The General Conference thought the response, which was in letter form, did not comply with the rules, and notified the defendants that it would give them an extension, until June 15, 1987, to file an amended answer. No amended answer was filed by that deadline.

On July 15, 1987, the General Conference filed a motion for judgment on the pleadings, or in the alternative, a motion to strike the answer of Marik and the Congregational Church. A hearing on the motion was scheduled for September 8, 1987. On August 4, 1987, the defendants filed a "Denial of Plaintiff's Allegations." Pursuant to local rule, a scheduling conference was held August 10, 1987, before a magistrate. The magistrate advised Marik that the Congregational Church was an eleemosynary corporation and could not be represented pro se, and advised the Congregational Church to obtain legal counsel. The court continued the conference for that purpose.

The defendants filed no response to the motion for judgment on the pleadings. Because it received no opposition to the motion, the court ordered that judgment on the pleadings be granted, and denied the motion to strike. The judgment and a permanent injunction were entered December 8, 1987. The injunction prohibits the defendants from using a name that includes the term "Seventh-Day Adventist" or "SDA," or promoting or representing to others that it is connected in any way with the General Conference. It also required the defendants to file a compliance report with the court within 30 days.

On December 28, 1987, the defendants, now represented by counsel, filed a motion for suspension of the injunction, a motion to set aside the judgment, and other related motions. On January 12, 1988, Marik and the Congregational Church filed a compliance report that stated that they refused to comply with the injunction because they believed the judgment was void for lack of subject matter jurisdiction, and because plaintiff's trademark was invalid. The General Conference re-

sponded with a motion to show cause why the defendants should not be held in contempt.

The district court denied defendants' motion to set aside the judgment, stating that the question whether "Seventh-Day Adventist" was a generic mark was one of law that had been decided in the judgment on the pleadings, and there was no reason to revisit the question upon a motion for new trial. The defendants filed a notice of appeal on April 7, 1988. The district court then entered an order to show cause why defendants should not be held in contempt, and set a hearing for May 9, 1988. The district court held both Marik and the Congregational Church in contempt, set a fine of $500 per day until compliance against both defendants, individually and collectively, and ordered that a warrant issue for Marik's arrest until full compliance with the injunction. The court also awarded plaintiff $13,929.21 for attorneys' fees and costs incurred in pursuing the contempt order.

DISCUSSION

[1] A judgment on the pleadings is a decision on the merits, and we review it *de novo*. *See McGlinchy v. Shell Chemical Co.*, 845 F.2d 802, 810 (9th Cir. 1988). Judgment on the pleadings is proper when there are no issues of material fact, and the moving party is entitled to judgment as a matter of law. Fed. R. Civ. P. 12(c). All allegations of fact by the party opposing the motion are accepted as true, and are construed in the light most favorable to that party. *McGlinchy*, 845 F.2d at 810. As a result, a plaintiff is not entitled to judgment on the pleadings when the answer raises issues of fact that, if proved, would defeat recovery. Similarly, if the defendant raises an affirmative defense in his answer it will usually bar judgment on the pleadings. *See* 5 C. Wright & A. Miller, *Federal Practice and Procedure* § 1368 (1969).

[2] The defendants filed two pleadings that the district court construed as "Answers." If we construe these "answers" liberally because Marik had submitted them pro se,[1] *see United States v. Ten Thousand Dollars ($10,000) in U.S. Currency*, 860 F.2d 1511, 1513 (9th Cir. 1988), they set forth two points that either raise questions of material fact, or present affirmative defenses. In the same permissive mode, the second "answer" filed after the motion for judgment on the pleadings, may be construed as an opposition to the motion. For these reasons, judgment on the pleadings was improper.

A. *Is "Seventh Day Adventist" a Generic Term?*

A trademark, even if it has become incontestable, is subject to the defense that the mark is generic. *Park 'N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 194-95 (1985). A trademark's function is to identify and distinguish the goods or services of one seller from another. 1. J. McCarthy, *Trademarks and Unfair Competition* § 12.1 (2d ed. 1984). A generic mark is one that tells the buyer what the product is, rather than from where, or whom, it came. *Id.* A generic mark cannot be subject to trademark protection because it does not indicate the product or service's origin, but is the term for the product or service itself. *Id.*

[3] The defendants claim that the name "Seventh Day Adventist" is generic: it refers to a religion, rather than the church organization. *See Christian Science Bd. of Directors v. Evans*, 105 N.J. 297, 520 A.2d 1347 (1987). Marik discussed the generic nature of the church name in his "Answers." Construing the "Answers" liberally, we find that Marik sufficiently raised the issue as an affirmative defense when he stated:

---

[1]Marik purported to answer for his church, an eleemosynary corporation. Not being an attorney, he could not answer for the church. The district court did not strike the answer, however. The church was represented by counsel by the time of its motion for new trial.

> The phrase "Seventh-day Adventist" is not theirs alone, as they would like to claim, for it describes a system or set of Bible based christian beliefs, doctines [sic], and standards. One, therefore, is not necessarily a Seventh-day Adventist because of what organization he may be affiliated with, but rather, he is a Seventh-day Adventist because of what he believes. Seventh-day Adventism is a particular faith, and those that conscientiously hold to that faith are Seventh-day Adventists. For an example, there are many different "Baptist" churches, but they all have a very similar faith.

Even assuming everything the General Conference alleges is true, the defendants are not liable for trademark infringement if they prove that the mark is generic. Because this defense was raised in the answer, it bars a judgment on the pleadings.

B. *Likelihood of Confusion*

To establish trademark infringement, the plaintiff must prove that there is a likelihood of confusion from the defendant's use of a mark similar to plaintiff's. *See* 15 U.S.C. § 1114; *Century 21 Real Estate Corp. v. Sandlin*, 846 F.2d 1175, 1178 (9th Cir. 1988). Several factors are involved in determining likelihood of confusion, which is a question of fact. *See id.* at 1178-79; *Levi Strauss & Co. v. Blue Bell, Inc.*, 778 F.2d 1352, 1355 (9th Cir. 1985) (*en banc*). These factors include: 1) the strength of the plaintiff's mark/name; 2) the proximity of the parties' goods; 3) similarity of the marks/names; 4) evidence of actual confusion; 5) marketing channels used; 6) likely degree of purchaser care; 7) defendant's intent in selecting the mark/name; and 8) likelihood of expansion of product lines. *Accuride Int'l, Inc. v. Accuride Corp.*, 871 F.2d 1531, 1533-34 (9th Cir. 1989).

[4] In the "Answers," Marik makes several factual assertions regarding the likelihood of confusion. First, he notes that the

Congregational Church has "never in any way sought to deceive or confuse any one in regards to our name." He also states that the word "Congregational" in the name of his church is explanatory, and distinguishes the two different churches. He states that "people have been quick to recognize this," and that the church intentionally used the word "congregational" to clarify that they were not affiliated with the plaintiff. All of these factual allegations go to the issue of likelihood of confusion, and create a question of material fact that should not have been determined in a judgment on the pleadings.

C. *Other Matters*

Defendants attempt to challenge the order of the district court holding them in contempt. That order was entered, however, after the notice of appeal was filed. The order appealed from was not stayed. The notice of appeal stated that the appeal was from the judgment and injunction entered on December 8, 1987, and from the order denying new trial entered on March 16, 1988. It does not bring before us the later contempt order, and we decline to rule upon it. Further relief, if any, must come from the district court.

Because the contempt order is not before us, we deny the motion to supplement the record on appeal with the record of the contempt proceedings. We also deny, as not in compliance with Fed. R. Evid. 201, defendants' motion to take judicial notice of certain "adjudicative facts."

Remaining points urged by the defendants are without merit.

CONCLUSION

The judgment on the pleadings in favor of plaintiff is **REVERSED**, and the cause is **REMANDED** to the district court for further proceedings.

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Attorney for Defendants

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF HAWAII

GENERAL CONFERENCE CORPORATION OF SEVENTH-DAY ADVENTISTS,	§	CIVIL ACTION NO. 87 0274
	§	
	§	NOTICE OF APPEAL FROM A JUDGMENT AND/OR ORDER OF A DISTRICT COURT TO A COURT OF APPEALS
Plaintiff,	§	
	§	
SEVENTH-DAY ADVENTIST CONGREGATIONAL CHURCH and JOHN R. MARIK,	§	
	§	
	§	
Defendants.	§	
	§	

NOTICE OF APPEAL FROM A JUDGMENT AND/OR ORDER OF A DISTRICT COURT TO A COURT OF APPEALS

NOTICE OF APPEAL

Notice is hereby given that the Seventh-day Adventist Congregational Church and John R. Marik, Defendants above named, hereby appeal to the United States Court of Appeals for the Ninth Circuit from Judgment and Permanent Injunction entered in this action on December 8, 1987, and from Order entered in this action on March 16, 1988, denying Defendants' Motion to Set Aside Judgment, to Dismiss or for New Trial, for a More Definite Statement, and to Strike Under FRCP 59 and FRCP 12.

DATED: Houston, Texas, April 5, 1988.

Respectfully submitted,

Max A. Corbett
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(713) 444-2340
Attorney for Defendants

NO. 88-2506
UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

GENERAL CONFERENCE CORPORATION OF SEVENTH-DAY ADVENTISTS,
Plaintiff-Appellee,

vs.

SEVENTH-DAY ADVENTIST CONGREGATIONAL CHURCH and JOHN R. MARIK
Defendants-Appellants

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF HAWAII

BRIEF FOR APPELLANTS

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560 F.2d 561 (C.A. 3, 1977); Avoyelles Sportmen's League, Inc.-v. Marsh, 715 F.2d 897 (C.A. 5, 1983). Additionally, the order of the Court on March 16, 1988, was res judicata as to issues before the Court. American Surety Co. v. Baldwin, 287 U.S. 156, 77 L.Ed 231, 53 S.Ct 98 (1932), 86 ALR 29. Cited with approval in Ins. Corp. of Ireland v. Compagnie Des Bauxites, 456 U.S. 694, 706, 707, 72 L.Ed.2d 492, 504, 102 S.Ct 2099, 2106 (1982). Accordingly, the order to show cause should have been vacated on motion therefor.

5.7.2.7 Procedural Due Process

In the hearing held on May 9, 1988, pursuant to Order to Show Cause Why Defendants Should Not Be Held in Contempt, an offer was made to present evidence why Defendants were not in contempt, and such offer was refused, and exception duly made and noted. This is a denial of procedural due process. In Cooke v. United States, 267 U.S. 517, 537, 69 L.Ed 767,774, 45 S.Ct 390, 395 (1925) the Court held: "Due process of law, therefore, in the prosecution of contempt, except of that committed in open court, requires that the accused should be advised of the charges and have a reasonable opportunity to meet them by way of defense or explanation." This case was followed in United States v. Lumumba, 741 F.2d 12 (C.A. 2, 1984). See *Civil and Criminal Contempt*, 73 Harvard Law Review 333 (1959).

5.7.2.8 Laches

A number of Seventh-day Adventists have been disfellowshipped from time to time because of refusal to follow the hierarchy of the church. These disfellowshipped ones have formed their own churches bearing the name Seventh-day

NO. 88-2506

UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

GENERAL CONFERENCE CORPORATION OF SEVENTH-DAY ADVENTISTS,
Plaintiff-Appellee,

vs.

SEVENTH-DAY ADVENTIST CONGREGATIONAL CHURCH and JOHN R. MARIK
Defendants-Appellants.

APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF HAWAII

REPLY BRIEF OF APPELLANTS

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Attorney for Appellants

2.7.2 Procedural Due Process

In a civil contempt proceeding the introduction of evidence is proper in regard to the issue of inability to comply with a judgment or order of the Court. Donovan v. Mazzola, 761 F.2d 1411 (C.A. 9, 1985). The introduction of evidence is also permissible with regard to other issues. One such issue is the matter of subject matter jurisdiction where there has been an actual contest of such issue. Chicot County Drainage District v. Baxter State Bank, 308 U.S. 371, 84 L.Ed 329, 60 S.Ct 317 (1940), noted 1940, 28 Geo.L.J. 1006, 53 Harv.L.Rev. 652, 49 Yale L.J. 959; Commodity Futures Trading Comm'n v. Nahas, 738 F.2d 487 (C.A. D.C. 1984). An offer was made in the May 9, 1988, hearing to present evidence, including that related to this specific issue. When the jurisdiction of a federal court is questioned, the court has the power and duty to determine the jurisdictional issue. Familia de Boom v. Arosa Mercantil, S.A., 629 F.2d 1134 (C.A. 5, 1980), cert den 451 U.S. 1008, 60 L.Ed.2d 861, 101 S.Ct 2345; Thornhill Publishing Co. v. General Tel. & Electronics Corp., 594 F.2d 730 (C.A. 9, 1979). A failure to provide Appellants with proper notice and an opportunity to be heard is subject to collateral attack. Wuchter v. Pizzutti, 276 U.S. 13, 72 L.Ed 446, 48 S.Ct 259, 57 A.L.R. 1230 (1928). "Notice" and "power" are inseparable aspects of due process requirements. Pennoyer v. Neff, 5 Otto (95 U.S.) 714, 24 L.Ed 565 (1877).

Accordingly, there has been a denial of procedural due process.

2.7.3 Laches

The doctrine of laches, that is, the inexcusable

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TELEPHONE
(713) 444-2840

January 12, 1990

Chief Judge Harold M. Fong
United States District Court
for the District of Hawaii
300 Ala Moana Boulevard
Honolulu, Hawaii 96813

Re: General Conference Corporation of Seventh-day Adventists, Plaintiff, v. Seventh-day Adventist Congregational Church and John R. Marik, Defendants, U.S. Hawaii District Court No. 87-0274, U.S. Ninth Circuit Court of Appeals No. 88-2506, U.S. Supreme Court No. 89-1061.

Dear Chief Judge Fong:

I am in receipt of letter addressed to you dated January 8, 1990, of Ms. Lorraine H. Akiba, Attorney for Plaintiff in the referenced case.

You are advised that a Petitition for Writ of Certiorari was filed in the referenced case with the United States Supreme Court on December 29, 1989. A copy of such Petition for Writ of Certiorari is enclosed. Your attention is particularly directed to Section 6.4 of such Petition entitled: THE COURT BELOW HAS ERRED IN NOT HOLDING THAT THE CONTEMPT ORDER OF THE DISTRICT COURT WAS BEFORE THE COURT FOR DECISION, AND THAT SUCH ORDER WAS VOID AND OF NO FORCE AND EFFECT, AND ORDERING A RECISION OF THE WARRANT FOR ARREST OF JOHN R. MARIK. In other words, I decidely differ in opinion with Ms. Akiba, for she concludes that I "did not properly appeal from the contempt order." It is also apparent that we differ considerably as to what "remaining issues" remain to be resolved - thus the necessity for filing the Petition in the first instance.

I appreciate the "humanitarian gesture" made by the General Conference but, a more "humanitarian gesture" would have been for them not to have trademarked the name "Seventh-day Adventist" in the first instance, for even one whom they consider to be a prophetess of God, Ellen G. White, said: "We are Seventh-day Adventists. Are we ashamed of *our* name? We answer, 'No, no! We are not. It is the name the Lord has given us." 2 Selected Messages 284. The defendants in this case consider themselves to be Seventh-day Adventists. How can they with a clear conscience before God abandon that name when it is God given. Harold, don't you believe you name is God given? Would you abandon it simply because someone contendend that you no longer had a right to use it? You understanding would be appreciated in the course taken to seek the best interests of this small persecuted group.

Very truly yours,

Max A. Corbett

Appendix I

CADES SCHUTTE FLEMING & WRIGHT
ATTORNEYS AT LAW

January 8, 1990

HAND DELIVERED

Chief Judge Harold M. Fong
United States District Court
for the District of Hawaii
300 Ala Moana Boulevard
Honolulu, Hawaii 96813

Re: General Conference Corporation of Seventh-Day Adventists v. Seventh-Day Adventist Congregational Church, et al.; Civil No. 87-0274

Dear Chief Judge Fong:

I am writing on behalf of the Plaintiff General Conference Corporation of Seventh-Day Adventists ("General Conference") in the above-referenced case. The General Conference was recently informed that Mr. John Marik, a Defendant in the case, has been arrested pursuant to an outstanding contempt order and arrest warrant issued by this Court on May 12, 1988.

On behalf of the General Conference, I previously informed Mr. Marik's attorney, Max Corbett, of the various alternatives available both in the District Court and at the appellate level to seek a stay of the contempt order and arrest warrant. However, Mr. Corbett did not seek a stay from either the District Court or the Ninth Circuit Court of Appeals and did not properly appeal from the contempt order, which still remains in effect.

The case has since been remanded by the Ninth Circuit to the District Court in Hawaii for further proceedings. In light of the remand, the General Conference would encourage release of Mr. Marik pending resolution of the remaining issues in the case and would not oppose any attempts by his attorney to obtain relief from this Court with respect to the outstanding contempt order and arrest warrant issued by this Court.

The General Conference realizes that this matter is out of its hands, since the contempt order remains in effect and the Court retains jurisdiction to enforce its orders. However, as a humanitarian gesture, the General Conference has informed the Court of its position on this matter. Because the General Conference cannot do so on behalf of Mr. Marik, we would urge Mr. Corbett to take appropriate steps to seek relief for his client. We would also reiterate our support of Mr. Marik's release, should Mr. Corbett make such a request to the Court.

Very truly yours,

Lorraine H. Akiba
for
CADES SCHUTTE FLEMING & WRIGHT

cc: U.S. Marshall's Office,
Inspector Larry Tice
Max Corbett, Esq.